UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,138	02/16/2005	Darwin He	NL 020795	1795

24737   7590   12/16/2008
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EXAMINER
SANDERS, STEPHEN

ART UNIT	PAPER NUMBER
2439	

MAIL DATE	DELIVERY MODE
12/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6 and 8-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-6 and 8-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This Office action has been issued in response to the received Request for

Continued Examination filed November 19, 2008 and the amendment filed October 27,

2008. Claims 1, 2, 4-6, and 8-15 are currently pending, in which claims 1, 5-6, and 8-9

are in independent form. It is noted that claims 1, 5, 6, and 8-15 have been amended

and claims 3, 7, and 16-17 have been cancelled.

Status of Claims:

Claims 1, 2, 4-6, and 8-15 are rejected under 35 U.S.C. 103(a).

Response to Amendment

Applicant's amendments to the Claims have been received and entered.

Response to Arguments

Applicant's Remarks filed October 27, 2008 have been fully considered and are

moot in view of new grounds of rejection as shown below.

Specification

1.   The disclosure is objected to because of the following informalities: The

Specification does not include and describe Figure 1's label 12.

        Appropriate correction is required.

35 USC § 112, 6th Paragraph

2.   The following is a quotation of 35 U.S.C. 112, 6th Paragraph:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

3.   The language of multiple elements within independent claim 6 recited the means-plus-function language and invoked 35 U.S.C. 112, sixth paragraph. These claim elements of independent claim 6 contain the "means for" phrase, and are modified by the following functional language respectively: "retrieving memory medium properties …"; "authenticating said memory medium …"; and "blacklisting the device …". Additionally, they are not modified by <u>sufficient</u> structure and thereby are being treated under 35 U.S.C. 112, sixth paragraph.

4.   No other claims and/or claim elements invoke 35 U.S.C. 112, sixth paragraph.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1, 2, 4-6, and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Valente et al (U.S. Publication Number 2003/0110192 A1), hereinafter Valente.

As to claim 1, the following is taught: "A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, authenticating the memory medium by comparing said memory medium properties with the ones of a corresponding memory medium legally produced by a provider, before sending the additional data to the device" (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; See claims starting page 16);

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 1, but fails to teach: "blacklistinq the device if the remote unit receives a number of requests higher than a predetermined threshold from the device containing a non-authenticated memory medium". However, Valente teaches blacklisting a device after it exceeds a number of attempts of "illegal" operations and renders device incapable of conducting further activities (Valente: page 6, paragraph [0070]). In view of Valente's teachings regarding blacklisting techniques, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include blacklisting techniques in determining device authentication. Although these specifics are not recited by Schwartz, one would be motivated to use

any and all blacklisting techniques in order to provide for better and faster authentication

management.

As to claim 2, the following is taught: "The communication method as claimed in

claim 1, wherein the memory medium properties are written in a control data zone of the

memory medium." (Schwartz teaches: Abstract, Detailed Description of the Preferred

Embodiment: page 4, lines 4-8; page 5, lines 6-11; See claims starting page 16).

As to claim 4, the following is taught: "The communication method as claimed in

claim 1, wherein the remote unit is able to send different types of additional data as a

function of the memory medium properties." (Schwartz teaches: Detailed Description of

the Preferred Embodiment: page 13, line 27 to page 14, line 2; See claims starting page

16).

As to claim 5, the following is taught: "A communication system comprising a

device able to read a memory medium, and a remote unit comprising additional data for

the memory medium, said device and the remote unit communicating via a network,

wherein the remote unit is able to retrieve memory medium properties from the memory

medium inserted in the device, to authenticate said memory medium by comparing said

memory medium properties with the ones of a corresponding memory medium legally

produced by a provider, before sending the additional data to said device" (Schwartz

teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2,

lines 10-12; page 4, lines 4-8; page 5, lines 20-22; See claims starting page 16);

As to the above parenthesized references, Schwartz teaches the referenced

elements of claim 5, but fails to teach: "blacklistinq the device if the remote unit

receives a number of requests higher than a predetermined threshold from the device

containing a non-authenticated memory medium". However, Valente teaches

blacklisting a device after it exceeds a number of attempts of "illegal" operations and

renders device incapable of conducting further activities (Valente: page 6, paragraph

[0070]). In view of Valente's teachings regarding blacklisting techniques, it would have

been obvious to an artisan of ordinary skill in the art at the time the invention was made

to specifically include blacklisting techniques in determining device authentication.

Although these specifics are not recited by Schwartz, one would be motivated to use

any and all blacklisting techniques in order to provide for better and faster authentication

management.

As to claim 6, the following is taught: "A remote unit for communicating with a

device able to read a memory medium, the remote unit comprising additional data for

the memory medium, means for retrieving memory medium properties from the memory

medium inserted in the device, means for authenticating said memory medium by

comparing said memory medium properties with the ones of a corresponding memory

medium legally produced by a provider, before sending the additional data to said

device" (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2,

line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5,
lines 6-11; page 5, lines 20-22; See claims starting page 16).

As to the above parenthesized references, Schwartz teaches the referenced
elements of claim 6, but fails to teach: "blacklistinq the device if the remote unit
receives a number of requests higher than a predetermined threshold from the device
containing a non-authenticated memory medium". However, Valente teaches
blacklisting a device after it exceeds a number of attempts of "illegal" operations and
renders device incapable of conducting further activities (Valente: page 6, paragraph
[0070]). In view of Valente's teachings regarding blacklisting techniques, it would have
been obvious to an artisan of ordinary skill in the art at the time the invention was made
to specifically include blacklisting techniques in determining device authentication.
Although these specifics are not recited by Schwartz, one would be motivated to use
any and all blacklisting techniques in order to provide for better and faster authentication
management.

As to claim 8, the following is taught: "A computer readable medium embodying
a computer program comprising program instructions for implementing, when said
program is executed by a processor, a communication method via a network between a
device able to read a memory medium, and a remote unit comprising additional data for
the memory medium, said communication method comprising the acts of: extracting
memory medium properties from the memory medium inserted in the device, sending
said memory medium properties to the remote unit (Schwartz teaches: Abstract;

Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed

Description of the Preferred Embodiment: page 3, lines 1-10; page 5, lines 9-11; page 5

line 26 to page 12, line 26; See claims starting page 16).

As to the above parenthesized references, Schwartz teaches the referenced

elements of claim 8, but fails to teach: "blacklistinq the device if the remote unit

receives a number of requests higher than a predetermined threshold from the device

containing a non-authenticated memory medium". However, Valente teaches

blacklisting a device after it exceeds a number of attempts of "illegal" operations and

renders device incapable of conducting further activities (Valente: page 6, paragraph

[0070]). In view of Valente's teachings regarding blacklisting techniques, it would have

been obvious to an artisan of ordinary skill in the art at the time the invention was made

to specifically include blacklisting techniques in determining device authentication.

Although these specifics are not recited by Schwartz, one would be motivated to use

any and all blacklisting techniques in order to provide for better and faster authentication

management.

As to claim 9, the following is taught: "A computer readable medium embodying

a computer program comprising program instructions for implementing, when said

program is executed by a processor, a communication method via a network between a

device able to read a memory medium, and a remote unit comprising additional data for

the memory medium, said communication method comprising the acts of: retrieving

memory medium properties from the memory medium inserted in the device,

authenticating the memory medium by comparing said memory medium properties with

the ones of a corresponding memory medium legally produced by a provider, before

sending the additional data to the device (Schwartz teaches: Abstract; Summary of

Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description

of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 5, line 26 to

page 12, line 26; See claims starting page 16).

As to the above parenthesized references, Schwartz teaches the referenced

elements of claim 9, but fails to teach: "blacklistinq the device if the remote unit

receives a number of requests higher than a predetermined threshold from the device

containing a non-authenticated memory medium". However, Valente teaches

blacklisting a device after it exceeds a number of attempts of "illegal" operations and

renders device incapable of conducting further activities (Valente: page 6, paragraph

[0070]). In view of Valente's teachings regarding blacklisting techniques, it would have

been obvious to an artisan of ordinary skill in the art at the time the invention was made

to specifically include blacklisting techniques in determining device authentication.

Although these specifics are not recited by Schwartz, one would be motivated to use

any and all blacklisting techniques in order to provide for better and faster authentication

management.

As to claim 10, the following is taught: "The communication method of claim 1,

wherein the memory medium comprises at least one read-only, recordable, and

rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of

Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 11, the following is taught: "The communication method of claim 1,

wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray

discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention:

page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 12, the following is taught: "The communication system of claim 5,

wherein the memory medium comprises at least one read-only, recordable, and

rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of

Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 13, the following is taught: "The communication system of claim 5,

wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray

discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention:

page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 14, the following is taught: "The remote unit of claim 6, wherein the

memory medium comprises at least one read-only, recordable, and rewritable discs

(Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1,

lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 15, the following is taught: "The remote unit of claim 6, wherein the

memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs

(Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1,

lines 19-25; page 2, lines 18-21; See claims starting page 16).

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Cox (U. S. Patent Number 6,456,725); Hughes (U. S. Patent

Number 7,454,779); Kaler (U. S. Patent Number 7,373,666); Borella (U. S. Patent

Number 7,028,335).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to STEPHEN SANDERS whose telephone number is

(571)270-5308. The examiner can normally be reached on M - F; 7:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kambiz Zand can be reached on 571-272-3811. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Sanders/
Examiner, Art Unit 2439

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434